

REMARKS

Claims 1-21 stand in this application. Reconsideration and allowance of the standing claims are respectfully requested.

Claims 1-5 and 10-21 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-5 and 10-21 of copending Application No. 10/145,998. A terminal disclaimer is filed herewith. Removal of this provisional rejection is respectfully requested.

Claims 1-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over copending Application No. 10/145,998 and document number XP-000870630 (Rosenberg) in view of document number XP-002242382 (Schulzrinne). Applicant respectfully traverses this rejection.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to the MPEP, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness since the references fail to teach or suggest all the claim limitations of claims 1-21.

Claims 1-9 represent patentable subject matter since the references fail to teach or suggest all the claim limitations of claims 1-9. Claim 1 recites "a pass through server connected to said data network and through which information between said proxy server and any of said terminals passes." Claims 2-9 depend from claim 1. According to the Office Action, Rosenberg describes the pass through server of claim 1 as the redirect servers for company.com as shown in FIG. 1 of Rosenberg. Office Action, Page 4. The redirect server, however, merely redirects a caller to another address for the called party. Rosenberg, Page 43, Col. 1: Paragraph 2. By way of contrast, (the pass through server of claim 1 is made aware of all the information passed between a proxy server and any of the terminals for a phone call). The redirect server in Rosenberg does not see any of the call information beyond the initial INVITE request, and therefore is not a pass through server as recited in claim 1. Similarly, Schulzrinne discloses a conventional redirect server similar to the one disclosed by Rosenberg. According to Schulzrinne, "[r]edirect servers receive requests and then return the location of another SIP user agent or server where the user might be found." Schulzrinne, Page 135, Col. 1, Paragraph 3. Again, this is not a pass through server as recited in claims 1-9. Removal of the rejection for claims 1-9 is therefore respectfully requested.

Claims 10-16 represent patentable subject matter since the references fail to teach or suggest all the claim limitations for claims 10-16. Claim 10 recites use of a fake inbound call message. The fake inbound call message allows an application computer to

initiate a phone call via the pass through server or proxy server. Specification, Page 17: Line 14 to Page 18: Line 4. Claims 11-16 depend from claim 10. Both Rosenberg and Schulzrinne fail to mention the use of a fake inbound call message. Further, both references never disclose a reason why such a fake inbound call message would be needed, since both references disclose conventional SIP telephony systems. Removal of the rejection for claims 1-16 is therefore respectfully requested.

Claims 17-21 represent patentable subject matter since the references fail to teach or suggest all the claim limitations for claims 17-21. Claim 17 recites "receiving commands from an applications computer" and "causing one or more terminals to initiate Internet telephone calls." Claims 18-21 depend from claim 17. The redirect servers disclosed by the references are not capable of initiating a telephone call between terminals. Rather, the redirect servers are limited to redirecting an INVITE request to a different address. Although Rosenberg describes the use of service logic to enhance functions for a SIP server, these enhancements are limited to SIP messages passed to the service logic. There is no mention whatsoever of the service logic being capable of "causing one or more terminals to initiate Internet telephone calls." The service logic is not capable of initiating a telephone call. Removal of the rejection for claims 17-21 is therefore respectfully requested.

For at least the above reasons, Applicant submits that claims 1-21 recite novel features not shown by the cited references. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Appl. No. 10/092,832

Reply to Office Action of 11/26/03

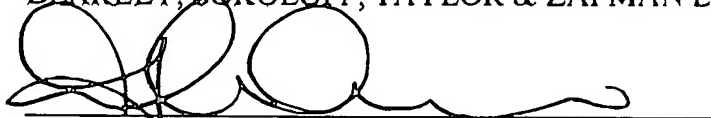
It is believed that claims 1-21 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned at 724-933-3387 to discuss any matter concerning this application.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 02-2666.


Respectfully submitted,

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Under 37 CFR 1.34(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to:
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Deborah Higham

2/26/04
Date

Dated: 2/26/04

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